UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,216	03/25/2004	Seiji Kawa	450100-04966	6582

7590 05/04/2006	**EXAMINER**
William S. Frommer, Esq. FROMMER LAWRENCE & HAUG LLP 745 Fifth Avenue New York, NY 10151	FABER, DAVID

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		10/809,216	KAWA ET AL.
		Examiner	Art Unit	
		David Faber	2178	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 March 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-14</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-14</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>25 March 2004</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/25/04, 9/20/04</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the application filed 25 March 2004.

This office action is Non-Final.

2.   Claims 1-14 are pending. Claims 1, 7, 8, 9, 13, and 14 are independent Claims.

Priority

3.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d).

Information Disclosure Statement

4.   The information disclosure statement (IDS) submitted on 25 March 2004 and 20

September 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the

information disclosure statement is being considered by the examiner.

Drawings

5.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference character(s) not mentioned in the

description: S61, S62, S63, S64, S65, S67, S68 of FIG 27; S91, S92, S94, S99 of FIG

32, and S121-S128 of FIG. 35. Corrected drawing sheets in compliance with 37 CFR

1.121(d), or amendment to the specification to add the reference character(s) in the

description in compliance with 37 CFR 1.121(b) are required in reply to the Office action

to avoid abandonment of the application. Any amended replacement drawing sheet

should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. Each drawing sheet submitted after the filing

date of an application must be labeled in the top margin as either "Replacement Sheet"

or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

7.   Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

8.   Claim 5 recites the term "processible" in line 4. Examiner is unsure what

Applicant means by the term "processible" since it is not defined by the Applicant nor by

a U.S. dictionary. Therefore, throughout this Office action, Examiner views the term

"processible" as "being processed".

9.   The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

> An element in a claim for a combination may be expressed as a means or step for
> performing a specified function without the recital of structure, material, or acts in support
> thereof, and such claim shall be construed to cover the corresponding structure, material,
> or acts described in the specification and equivalents thereof.

10.   As per independent Claim 1, Claim 1 recites the limitation "first acquiring means

for…" Examiner is unsure is the means for is referring to any hardware since apparatus

is referring to software, pro se.

Claim Rejections - 35 USC § 101

11.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12.   Claims 1-6, 8, 9-12, and 14 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter.

> For your reference, below is a section from MPEP 2105 :
>
> (a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se
> **Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory** because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.
> Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.
> Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when

a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

13.   Claims 1-6, and 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to be claiming "software systems" i.e. systems without hardware indication, which is computer program per se. Since the computer program is not embodied on a tangible computer readable medium, they appear non-statutory.

14.   Claims 8, and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are claiming a computer program per se. A computer program not embodied on a tangible computer readable medium is not statutory.

Claim Rejections - 35 USC § 102

15.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16.   Claim 1, 3-14 are rejected under 35 U.S.C. 102(b) as being anticipated by

Yasuda et al (EP 0 855 714 A2, published 7/29/1998).

As per independent Claim 1, Yasuda et al discloses a apparatus comprising: first

acquiring means for acquiring edit point information and describing an edit point set for

said data; creating means for creating reproduction control information in accordance

with said edit point information acquired by said first acquiring means, said reproduction

control information resulting from an editing process based on said edit point and

serving to control reproduction of said data. . (Column 5, line 45-58: Discloses a storage

medium comprising picture data as well as reproduction information which is read out

by a read-out unit (acquiring data), wherein this information would be use to reproduce

data such discloses in FIG 3(A-C), and FIG 6.)

As per dependent Claim 3, Yasuda et al discloses designating a decoder.

(Column, lines 2-9; 29-49, FIG. 5: Discloses being delivered to a decoder, and its

functionality)

As per dependent Claim 4, Yasuda et al discloses determining a location at

which said reproducing apparatus reproducing said data, and information for

designating the starting location determined by said determining means. (Column 5,

lines 52-55; Column 8, lines 48-50)

As per dependent Claim 5, Kelly et al discloses designating said starting location

by said determining means using address information processible by said reproducing

apparatus. (Column 8, line 48 – Column 9, line 4: Containing the data for the starting

point would include the address of the location within the signal.)

As per dependent Claim 6, Claim 6 recites similar limitations as in Claim 1 and is similarly rejected under rationale. Furthermore, Yasuda et al discloses an apparatus further disclosing comprising second acquiring means which, if said data are constituted by pictures, then acquires picture information about said pictures; wherein said creating means creates said reproduction control information in accordance with said picture information acquired by said second acquiring means. (Column 5, line 30- Column 6, lines 23: Discloses coded data string consisting of aforementioned I pictures, B picutures, and P pictures wherein a read-out unit reads (acquires) the data from the storage medium wherein reproduction is obtained that used for editing the picture data.)

As per independent Claim 7, Claim 7 recites a method for performing the apparatus of Claim 1 and is similarly reject under rationale.

As per independent Claim 8, Claim 8 recites a program for performing the apparatus of Claim 1 and is similarly reject under rationale.

As per independent Claim 9, Yasuda et al discloses an apparatus comprising acquiring means for acquiring reproduction control information, which is created in accordance with edit point information describing an edit point set for data and which serves to control reproduction of said data; and reproducing means for reproducing said data in accordance with said reproduction control information acquired by said acquiring means. (Column 5, line 45-58: Discloses a storage medium comprising picture data as well as reproduction information which is read out by a read-out unit (acquiring data), wherein this information would be use to reproduce data such discloses in FIG 3(A-C), and FIG 6.)

As per dependent Claim 10, Yasuda et al discloses an apparatus comprising

- determining means and selecting means for use when said reproduction control information includes information for indicating as a reproduction object data, which are relocated by an information creating apparatus for creating said reproduction control information and which are in proximity of said edit point (Column 5, lines 45-50: Discloses coded data string to reproduced, wherein the coded data is selected and reproduced (Column 6, lines 2-9,16-23; FIG 3,8; Column 9, lines 5-46)

- determining means determines a location at which to start reproducing said data accordance with said reproduction control information; (Column 5, lines 52-54: reproduction start point)

- selecting means selects a decoder for reproducing said data; and (FIG 5; Column 6, lines 2-9, 33-49: Discloses a decoding unit is presented. During operation, the method uses (selects) the decoder presents to perform its functionality.)

- wherein said reproducing means reproduces said data based on said reproduction control information, on the starting location determined by said determining means, and on said decoder selected by said selecting means. (Column 5, lines 2-9, 16-24, 29-49)

As per dependent Claim 11, Claim 11 recites similar limitations as in Claim 10, and is similar rejected under rationale.

As per dependent Claim 12, Claim 12 recites similar limitations as in Claim 10, and is similar rejected under rationale.

As per independent Claim 13, Claim 13 recites a method for performing the method of Claim 9, and is similarly rejected under rationale.

As per independent Claim 14, Claim 14 recites a program for performing the method of Claim 9, and is similarly rejected under rationale.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al (EP 0 855 714 A2, published 7/29/1998) in further in view of Kelly et al (WO 99/48096, published 9/23/1999).

As per dependent Claim 2, Yasuda et al discloses information for indicating said data relocated by said relocating means as a reproduction object (Column 5, lines 45-50: Discloses coded data string to reproduced, wherein the coded data is selected and reproduced (Column 6, lines 2-9,16-23; FIG 3,8; Column 9, lines 5-46) but fails to specifically disclose an apparatus comprising: determining means for determining whether it is possible for said reproducing apparatus to reproduce in real time said data

resulting from said editing process; and relocating means for relocating data in proximity of said edit point if said determining means determines that it is impossible for said reproducing apparatus to reproduce in real time said data resulting from said editing process. However, Kelly et al discloses a system recording real time information signal for editing (Page 1, lines 1-5) wherein on Page 5, lines 15-35, Kelly et al discloses on how their system function when determining using real time data and wherein if the data is not real data.

It would been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Yasuda et al's method with Kelly et al's method since Kelly et al's method would have provided the benefit for a real time information signal recorded earlier on the record carrier can be reproduced without any interruption.

Conclusion

19.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

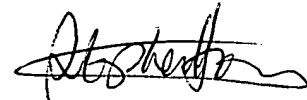- Kato et al (2002/0145702: Discloses reproduction of AV streams.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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